

### REMARKS

No claims have been amended or cancelled pursuant to this paper. Thus, claims 7-29, 78-89, and 146-149 are pending in the present application.

#### Examiner Telephone Interview

The Applicants appreciate with thanks the Examiner taking the time to discuss the present case in a telephone interview with the Applicants' undersigned representative on December 9, 2003. No agreement was reached with respect to the §103 rejections. The Examiner did agree to review the obviousness-type double patenting rejections, including the provisional rejections, and withdraw these rejections as appropriate.

#### Claims Rejections – 35 U.S.C. § 103

Claims 7-29, 78-89, and 146-149 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,880,096 to Kobyashi et al. in view of U.S. Patent No. Takizawa et al. The Applicants respectfully traverse these claim rejections and respectfully submit that the Applicants' claims are patentable over the cited references for at least the following reasons.

An obviousness rejection under §103 requires that all the limitations of a claim must be taught or suggested by the prior art. M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). A *prima facie* case of obviousness, *inter alia*, requires:

- (i) a “suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,” and
- (ii) that “the prior art reference[s] . . . must teach or suggest all the claim limitations.”

See M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)).

Claims 7-29 and 146-149 each recite the limitation of “an input receptacle for receiving a stack of bills to be evaluated.” Kobyashi does not disclose, teach, or suggest an input receptacle that receives a stack of currency bills. Rather, Kobyashi discloses a bill validator having a bill

insertion slit that is only capable of receiving one bill at a time. *See* Kobyashi at col. 6, lines 23-41.

Similarly, Takizawa is directed to “a bill examination device used in an automatic cash deposit/dispensation machine or an automatic vending machine.” *See* Takizawa at col. 1, lines 5-9 and col. 2, lines 23-28. The device of Takizawa does not have an input receptacle for receiving a stack of bills. Rather, Takizawa discloses a bill acceptor that receives and processes one bill at a time. *See, e.g.*, Takizawa at col. 1, lines 11-17 (“When a bill . . . is inserted or entered by a customer into an automatic cash deposit/dispensation machine or an automatic vending machine, the denomination of the bill is identified and the authenticity of the bill is tested.”).

Neither Kobyashi, Takizawa, nor a combination thereof disclose, teach, or suggest a currency evaluation device having “an input receptacle for receiving a stack of bills to be evaluated.” Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made and that claims 7-29 and 146-149 are patentable over Kobyashi in view of Takizawa under 35 U.S.C. § 103(a) for at least this reason.

Further, claims 78-89 requires a transport mechanism that transports a currency bill “such that the long edge of the bill is the leading edge of the bill.” Claims 146 and 147 require that bills are transported “such that their narrow dimension is parallel to the direction of transport. And claims 148 and 149 require the transporting of bills such that “a wide edge of the bills is the leading edge.” As discussed above, both Kobyashi and Takizawa are directed to bill validating devices that receive bills the narrow-edge of the bills first. *See, e.g.*, Takizawa at FIG. 2. The cited references do not teach, suggest, or disclose transporting bills with the wide edge leading as required by claims 78-89 and 146-149. Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made, and that claims 78-89 and 146-149 are patentable over Kobyashi in view of Takizawa under 35 U.S.C. § 103(a) for at least this reason.

Furthermore, claims 78-89, 146, and 147 require that “the plurality of magnetic sensor covering a substantial portion of a long dimension of the bill.” Claims 148 and 149 require “at least two magnetic sensors being adapted to scan a substantially continuous segment of each of the currency bills, the substantially continuous segment being parallel to the wide ledge of the currency bills.” Referring to Kobayashi’s FIG. 8, the two Kobayashi magnetic sensors (H1, H2) do not scan a substantial portion of a long dimension of the bill and do not scan a substantially

continuous segment of each of the bills that is parallel to the wide edge of the currency bills. Takizawa discloses, teaches, or suggests nothing regarding the positioning of any magnetic sensors. Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made, and that claims 78-89 and 146-149 are patentable over Kobayashi in view of Takizawa under 35 U.S.C. § 103(a) for at least this reason.

Further still, claims 11, 12, 17, 18, 26, 27, 81-87, 147, and 149 include limitations directed to the spacing of magnetic sensors in the magnetic scanhead. For example, claim 149 requires “the spacing between each of the at least two magnetic sensors is less than about one millimeter.” The cited references disclose, teach, or suggest nothing regarding the spacing of magnetic sensors. Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made, and that claims 11, 12, 17, 18, 26, 27, 81-87, 147, and 149 are patentable over Kobayashi in view of Takizawa under 35 U.S.C. § 103(a) for at least this reason.

Therefore, the Applicants respectfully submit that claims 7-29, 78-89, and 146-149 149 are patentable over Kobayashi in view of Takizawa under 35 U.S.C. § 103(a) for at least each of the foregoing reasons.

#### Obviousness-Type Double Patenting Rejections

Claims 7-29, 58-89, and 146-149 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patents Nos. 5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,806,650; 5,815,592; 5,867,589; 5,870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744; 6,220,419; 6,237,739; 6,241,069; 6,278,795; and 6,311,819. The Applicants respectfully traverse these rejections.

As the Applicants set forth in their two prior replies, an obviousness-type double patenting rejection requires the claims of the pending application to be compared to the claims of an application or a patent. *See* M.P.E.P. § 804. The present rejection repeats that same rejection set forth in the prior action without setting forth any basis for such rejections and without addressing the Applicants’ prior replies. In the present Office Action (as well as in the prior office action), none of the claims of the above-identified U.S. patents have been specifically identified as relating to the obviousness-type double patenting rejections. Thus, the Applicants again respectfully submit that these obviousness-type double patenting rejections are improper.

As discussed with the Examiner in the telephone interview, the claims of the present application require, *inter alia*, a “closely spaced magnetic sensors.” The claims of the cited patents do not include this limitation. Thus, the Applicants respectfully request that these obviousness-type double patenting rejections be withdrawn as discussed with the Examiner.

Provisional Obviousness-Type Double Patenting Rejections

Claims 7-29, 58-89, and 146-149 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Applications Serial Nos. 09/541,170; 09/542,487; 09/635,967; 09/607,019; 09/611,279; and 09/126,580.

Again, the office action sets forth the conclusion of provisional obviousness-type double patenting rejections without addressing the merits of any such rejections and without addressing the Applicants’ prior two replies to the same rejections. Rather, the present office action repeats the provisional obviousness-type double patenting rejections set forth in the prior office action.

To formulate an obviousness-type double patenting rejection, the claims of the pending application must be compared to the claims of an application or a patent. *See* M.P.E.P. § 804. In the Office Action, none of the claims of the above-identified copending applications has been specifically identified as relating to the obviousness-type double patenting rejections. Therefore, Applicants respectfully submit that these obviousness-type double patenting rejections are improper.

As discussed with the Examiner in the telephone interview, the claims of the present application require, *inter alia*, a “closely spaced magnetic sensors.” The claims of the cited application patents do not include this limitation. Thus, the Applicants respectfully request that these obviousness-type double patenting rejections be withdrawn as discussed with the Examiner.

Regarding the Examiner’s statement of the unavailability of U.S. Application Serial No. 09/864,423, the Applicants repeat their belief that this is not an application owned by the assignee of the present application. The Applicants again note that Application No. 08/864,423 is an application owned by the assignee of the present application and issued as U.S. Patent No. 6,311,819, which was recited in the obviousness-type double patenting rejection.

Conclusion

In conclusion, the Applicants respectfully submit that all claims are in condition for allowance and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned attorney at the number indicated.

The Applicants believe that no fee is due in connection with this paper. The Commissioner is authorized to charge any additional fees that may be required while this application is pending (except the issue fee) to Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447(47171-00271USP1).

Respectfully submitted,



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